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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,999	01/06/2006	Lothar Eggeling	23155	2791
535 7590 04/10/2008 K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900				
EXAMINER GEBREYESUS, KAGNEW H				
ART UNIT		PAPER NUMBER		
1656				
MAIL DATE		DELIVERY MODE		
04/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,999

Applicant(s)

EGGELING ET AL.

Examiner

KAGNEW H. GEBREYESUS

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10, drawn to a nucleic acid that encodes a 3-phosphoglycerate dehydrogenase, and vector comprising the same wherein said nucleic acid is a mutant ser A gene isolated from a *Corynebacterium* or *Brevibacterium*.

Group II, claim(s) 11-19, drawn to a mutant 3-phosphoglycerate dehydrogenase and variant thereof derived from a *Corynebacterium* or *Brevibacterium*.

Group III, claim(s) 20-26, drawn to a microorganism comprising a nucleic acid corresponding to a mutant ser A gene that encodes a 3-phosphoglycerate dehydrogenase or allele thereof.

Group IV, claim 27 is drawn to a method of producing L-serine using a microorganism transformed with an expression vector comprising a nucleic acid selected that encodes

a mutant 3-phosphoglycerate dehydrogenase and purifying the L-serine from the growth media.

The invention listed in Groups 1-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reason. The technical feature linking the invention of Groups I-IV is mutant SerA genes that that express mutant 3-phosphoglycerate dehydrogenase that cannot be regulated or that cannot be allosterically inhibited by L-serine. However Bell et al (Eur. J. Biochem. 269, 4176-4184 (2002)), teach mutation in the serine binding region of 3-phosphoglycerate dehydrogenase results in lose of allosteric inhibition by L-serine. Given that 3-phosphoglycerate dehydrogenase catalyses the 1st step in L-serine biosynthesis, it would have been obvious that lose of allosteric inhibition will result in overproduction of L-serine. Therefore the technical feature linking the invention in Groups I-IV is not a special technical feature as defined by PCT rule 13.2 as it does not define a contribution over the prior art.

Restriction Requirement Applicable to all Groups

Furthermore, the presence of multiple polypeptide sequences and polynucleotide sequences, each with a different SEQ ID NO: allows for a variety of patentably distinct products. Depending on the sequence of each polypeptide and polynucleotide, the characteristics of the resulting molecule will vary in regards to structure and function. Each one of these polypeptides is capable of eliciting a specific immune response and

can be used to produce a specific antibody; also each one of the mentioned polynucleotides is capable of hybridizing to different probes and is capable of encoding a characteristically different peptide in regards to structure and activity. Therefore these polypeptides and polynucleotides are patentably distinct absent factual evidence to the contrary. Rejoinder of all or a specified subset of the sequences is possible if Applicants provide a single and specific representative subsequence found in all or a specified subset of the sequences for search, and state that all or a specified subset of the sequences are not patentably distinct. Applicants are informed that if their specified sequence is found that all or a specified subset of sequences are obvious over that prior art sequence.

Applicant is required under 35 U.S.C. 121 to elect a single SEQ ID NO: for prosecution on the merits. The applicant should be aware that selection of a single SEQ ID NO: represents a response to a restriction requirement of a patentably distinct product, not an election of species.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAGNEW H. GEBREYESUS whose telephone number is (571)272-2937. The examiner can normally be reached on 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr Bragdon can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1656

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kagnew H Gebreyesus PhD/
Examiner, Art Unit 1656
/K. H. G./ 3/31/08

/Robert B Mondesi/
Primary Examiner, Art Unit 1652